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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/912,122	07/24/2001	Joshua Makower ₁	TRNSV-015G	4515

7590 09/30/2004

MEDTRONIC VASCULAR, INC.
IP LEGAL DEPARTMENT
3576 UNOCAL PLACE
SANTA ROSA, CA 95403

EXAMINER

ISABELLA, DAVID J

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 09/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/912,122

Applicant(s)

MAKOWER ET AL.

Examiner

DAVID J ISABELLA

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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Status of the Claims

A request for continuing examination was filed by the applicant on September 13, 2004. Amendment filed concurrently cancels claims 1-52 and adds new claims 53-63. The prosecution history of the previous claims was directed to elected embodiment of Figure 2 (original claims 5-11). Applicant made the election without traverse on September 13, 2003.

Specification

A substitute specification excluding the claims is required pursuant to 37 CFR 1.125(a) because pages 35,38 and 39 are missing.

A substitute specification must not contain new matter. The substitute specification must be submitted with markings showing all the changes relative to the immediate prior version of the specification of record. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. An accompanying clean version (without markings) and a statement that the substitute specification contains no new matter must also be supplied. Numbering the paragraphs of the specification of record is not considered a change that must be shown.

The use of the trademark IVUS has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 63 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of Trademarks are not allowed in the body of the claims.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 53,58,60,61 is rejected under 35 U.S.C. 102(b) as being anticipated by Foerster et al (4905667).

Foerster et al discloses a guide device (2) that is useable to guide the advancement of a guidewire (12) or other elongate member, said device comprising: a elongate catheter body having at least one lumen (19) extending longitudinally therethrough; an opening formed in said catheter body; and, a tubular member (10)

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having a lumen and a distal end opening, said tubular member being alternately disposable in; a) a retracted position wherein the tubular member is substantially within the catheter body; and b) an extended position wherein the tubular member assumes a curved configuration and extends out of the opening such that a guidewire or other elongate member may be advanced through the lumen of the tubular member and out of the distal end opening of the tubular member. (See figure 11)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 54,55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foerster et al (4905667) as applied to claim 53 above, and further in view of Shturman (5331947).

An imaging device comprising an anchoring member (32) being deployable when the catheter body is inserted into an anatomical lumen such that a surface of the balloon anchoring member will engage a wall of the anatomical lumen thereby preventing at least a portion of the catheter body from undergoing substantial movement within the anatomical lumen. To use the imaging device, combination of a balloon anchor/imaging means, of Shturman in place of the imaging probe of Foerster, et al so that the surgeon can precisely place and anchor the probe at the predetermined/selected location in vivo would have been obvious to one with ordinary

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skill in the art at the time of the invention thereof. Precise location and anchoring the probe to that location offers the surgeon better means for obtaining clear imaging resolution of the selected location.

Claims 56,57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foerster et al (4905667) in view of Shturman (5331947) as applied to claim 54 above, and further in view of Abele (6010480).

Examiner has applied Abele et al as a secondary teaching for increasing the frictional surface of a balloon catheter for increasing the engaging forces of the balloon to an adjacent luminal structure. It would have been obvious to one with ordinary skill in the art to provide the outer surface of the balloon with frictional components to increase the engaging forces of the outer surface of the balloon to adjacent luminal structures.


Claims 59 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Foerster et al (4905667) in view of Shturman (5331947) as applied to claim 54 above, and further in view of Seward et al (5345940).

To modify the single lumen catheter of Foerster et al to a multi-lumen catheter system capable of employing multiple tools via a single catheter thereby reducing the need for multiple independent catheters, would have been obvious to one with ordinary skill in the art in view of the teachings of Seward, et al. See columns 7 and 8 for claim 59.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DAVID J ISABELLA whose telephone number is 703-308-3060. The examiner can normally be reached on MONDAY-FRIDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CORRINE MCDERMOTT can be reached on 703-308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



DAVID J. SABELLA
Primary Examiner
Art Unit 3738

DJI
September 27, 2004